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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/824,610	04/15/2004	Tomohiro Oshima	L8612.04110	6394

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EXAMINER

HERRERA, DIEGO D

ART UNIT	PAPER NUMBER
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2617

DATE MAILED: 06/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/824,610	Applicant(s) OSHIMA ET AL.	
	Examiner Diego Herrera	Art Unit 2683	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 4/15/2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 April 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

The Art Unit location of your application in the USPTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Art Unit 2617.

Priority

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Drawings

The drawings are objected to because fig. 22 there's a misspelled word. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

The abstract of the disclosure is objected to because the word 'means'.

Correction is required. See MPEP § 608.01(b).

Claim 6 objected to because of the following informalities: dependency is incorrect. Appropriate correction is required.

Claim Objections

Claim 6 objected to under 37 CFR 1.75(c) as being in improper form because of claim 6 being dependent on itself. See MPEP § 608.01(n). For examination purposes, the examiner will consider claim 6 as statutory as dependent on independent claim 1.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 24-31 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 24-31 are drawn to a "computer program" *per se* as recited in the preamble and as such are non-statutory subject matter. See MPEP § 2106.IV.B.1.a. Data structures not claimed as embodied in computer readable media are descriptive material *per se* and are not statutory because they are not capable of causing functional change in the computer. See, e.g., *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure *per se* held nonstatutory). Such claimed data structures do not define any structural and functional interrelationships between the data structure and other claimed aspects of the invention, which permit the data structure's functionality to be realized. In contrast, a

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claimed computer readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and is thus statutory. Similarly, computer programs claimed as computer listings *per se*, i.e., the descriptions or expressions of the programs are not physical "things." They are neither computer components nor statutory processes, as they are not "acts" being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer, which permit the computer program's functionality to be realized.

The following is an example of what the examiner recommends the preamble should read as: "A computer useable medium having (program code)|(data structure) means embodied therein for causing (description of claims overall function), the computer readable (program code)|(data structure) means in said article of manufacture comprising:" For examination purposes, the examiner will consider claims 24-31 as statutory as per the above preamble.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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2. Claims 1-6, 8-18, & 20-31 are rejected under 35 U.S.C. 102(b) as being anticipated by Miyakoshi et al. (US PANT PUB 2002/0147819).
3. Regarding claim 1, Miyakoshi et al. discloses a wireless apparatus capable of being communicated to a plurality of terminal apparatus by a wireless manner (title, abstract, fig. 6, paragraphs [0001]-[0005]), comprising:
 - a. A wire interface for being communicated to said terminal apparatus by a wire manner (fig. 1- 17, abstract, title, paragraph [0011]-[0023], [0080]-[0120]); and
 - b. Control means for controlling a setting mode in which when said control means receives a transmit packet from said terminal apparatus connected to said wired interface and said transmit packet contains an address specific to said terminal apparatus, at least one of wireless setting information and network setting information is transmitted the terminal apparatus of said specific address (paragraphs [0020]-[0035], [0080]-[0120], Miyakoshi teaches transmission packets and control means in which specific protocols are followed).
4. Regarding claim 14, Miyakoshi et al. discloses a wireless terminal apparatus comprising:
 - a. Wireless communication control means for performing a wireless communication operation (fig. 2, abstract, paragraphs [0081]-[0087], Miyakoshi teaches communication control means liaisons between wireless and communication device);

- b. Wire communication control means for performing a wire communication operation via a wire interface (fig. 1, paragraph [0011]-[0023]); and
 - c. First control means operated in such a manner that either when a power supply is turned ON or when a network, or another wireless terminal apparatus is connected to the wire interface, said first control means broadcasts the own specific address to either said network or said another wireless terminal apparatus in a predetermined interval, and thereafter, when said first control means receives wireless setting information transmitted from either said network or said another wireless terminal apparatus, said first control means stores said received wireless setting information into storage means (fig. 1-6, title, abstract, paragraphs [0079]-[120], & [0208]-[0216]).
- 5. Regarding claim 22, Miyakoshi et al. discloses a wireless system comprising:
 - a. A wireless apparatus recited in claim 1 (claim 22 vis-à-vis claim 1), and
 - b. A wireless terminal apparatus recited in claim 14 (see claim 14 for response).
- 6. Regarding claim 23, Miyakoshi et al. discloses a method for setting a wireless system containing a terminal apparatus and a wireless apparatus capable of communicating with the terminal apparatus in a wireless manner (abstract, paragraphs [0011]-[0023]), comprising:
 - a. A step for connecting said terminal apparatus to said wireless apparatus in a wire manner (paragraphs [0011]-[0023]);
 - b. A step in which said wireless apparatus receives a transmission packet via a wire line from said terminal apparatus, and as transmission packet contains a

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specific address of said terminal apparatus (fig. 2-6, paragraphs [0081]-[119]);

and

c. A step in which said wireless apparatus transmits wireless setting information and/ or wireless setting information via the wire line with respect to the terminal apparatus of said specific address (abstract, fig. 3-4, paragraphs [0091]-[0116]).

7. Regarding claim 24, Miyakoshi et al. discloses a computer program for setting a parameter used to execute a communication operation with a wireless access point, wherein said computer program causes a computer to function as:

a. Setting information requesting means for requesting to transmit setting information for performing said parameter setting operation with respect to said wireless access point (fig. 5, paragraphs [0081]-[0120]);

b. Setting information receiving means for receiving said setting information which is transmitted from said wireless access point (fig. 6, paragraphs [0081]-[0120]);

c. Wireless unit judging means for judging as to whether or not a wireless unit is present in said computer (fig. 36-37, paragraphs [0331]-[0337]); and

d. Setting means operated in such a manner that when said wireless unit judging means judges that the wireless unit is present, the setting information received by said setting information receiving means is set to said wireless unit (fig. 36-37, paragraphs [0331]-[0337]).

8. Regarding claim 31, Miyakoshi et al. discloses a computer apparatus comprising: the computer recited in claim 24 (paragraphs [0029]-[0034]).

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9. Consider claim 2, and as applied to claim 1 above, Miyakoshi et al. discloses wherein said control means judges as to whether or not said at least one of said wireless setting information and said network setting information is transmitted based upon the specific address received from said terminal apparatus, and transmits said judged setting information to the terminal apparatus of said specific address (fig. 1-8, abstract, paragraphs [0102]-[0119]).

10. Consider claim 3, and as applied to claim 1 above, Miyakoshi et al. discloses further comprising display means (paragraphs [0086], [0120], [0134]); and

a. Wherein said control means causes said display means to display thereon such a fact that the transmission of said at least one of said wireless setting information and said network setting information is accomplished (paragraphs [0086], [0120], [0134]).

13. Consider claim 4, and as applied to claim 1 above, Miyakoshi et al. discloses wherein said wire interface is exclusively used so as to perform an operation as said setting mode (paragraphs [0012]-[0015], [0082]-[0083]).

14. Consider claim 5, and as applied to claim 1 above, Miyakoshi et al. discloses wherein the operation of said wire interface is switchable between the operation of said setting mode and an operation of a network interface (paragraphs [0011]-[0016], [0218]-[0220]).

15. Consider claim 6, and as applied to claim 1 above, Miyakoshi et al. discloses wherein said wireless apparatus corresponds to a router apparatus; and said network interface corresponds to a wire LAN interface (titles, abstract, fig. 6, paragraphs [0010]-

[0016], device connected to each other, communicating device and terminal.

Communicating device being the router for wireless communication hence wire LAN interface).

16. Consider claim 8, and as applied to claim 5 above, Miyakoshi et al. discloses wherein in the case that a predetermined specific address is contained in said transmission packet, the operation of said control means is controlled in such a manner that only the wireless setting information is transmitted, but the network setting information is not transmitted (paragraphs [0083]-[0085], [0097]-[0100], where controller controls flow of information only of wireless component communication transmission packet).

17. Consider claim 9, and as applied to claim 1 above, Miyakoshi et al. discloses wherein said wireless setting information corresponds to both encryption information and ID (identification) information (fig. 5, paragraphs [0094]-[0100]).

18. Consider claim 10, and as applied to claim 9 above, Miyakoshi et al. discloses wherein said control means automatically produces at least one of said encryption information and said ID information based upon the own specific address (paragraphs [0108]-[0113]).

19. Consider claim 11, and as applied to claim 1 above, Miyakoshi et al. discloses wherein said control means transmits at least one of said wireless setting information and said network setting information to the terminal apparatus, and also, stores said transmitted information to specific address storage means of said terminal apparatus (fig. 1-8, paragraphs [0094]-[0100], [0108]-[0113]).

20. Consider claim 12, and as applied to claim 10 above, Miyakoshi et al. discloses wherein said control means performs a wireless communication operation with respect only to the terminal apparatus of the specific address which has been stored in said specific address storage means (fig. 1-8, paragraphs [0094]-[0100]).

21. Consider claim 13, and as applied to claim 11 above, Miyakoshi et al. discloses wherein said control means stores a communication quality level corresponding to said specific address into said storage means, and is communicated to the terminal apparatus in accordance with said stored communication quality level (fig. 1-8, abstract, paragraphs [0102]-[0119]).

22. Consider claim 15, and as applied to claim 14 above, Miyakoshi et al. discloses wherein after said first control means has stored said wireless setting information into the storage means, said first control means broadcasts said wireless setting information with respect to said network (paragraphs: [0011]-[0017]).

23. Consider claim 16, and as applied to claim 14 above, Miyakoshi et al. discloses wherein when said first control means receives network setting information in addition to said wireless setting information, said first control means stores the received network setting information into the storage means in addition to said wireless setting information (fig. 1-8, paragraphs [0094]-[0100], [0108]-[0113]).

24. Consider claim 17, and as applied to claim 16 above, Miyakoshi et al. discloses wherein after said first control means has stored both said wireless setting information and said network setting information into the storage means, said first control means broadcasts both said wireless setting information and said broadcasts both said

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wireless setting information and said network setting information with respect to said network (fig. 1-8, paragraphs [0094]-[0100], [0108]-[0113]).

25. Consider claim 18, and as applied to claim 14 above, Miyakoshi et al. discloses further comprising switching means for switching the operations of said wire interface; and wherein said wireless interface is operated as said first control means by operating said switching means (paragraphs [0011]-[0016], [0218]-[0220]).

26. Consider claim 20, and as applied to claim 14 above, Miyakoshi et al. discloses wherein said wireless communication control means performs the wireless communication operation in accordance with the wireless setting information stored in said storage means (FIG. 36, paragraphs [0335]-[0339]).

27. Consider claim 21, and as applied to claim 14 above, Miyakoshi et al. discloses wherein said wireless communication control means performs the wireless communication operation in accordance with the wireless setting information stored in said storage means (FIG. 36-38, paragraphs [0335]-[0339]).

28. Consider claim 25, and as applied to claim 24 above, Miyakoshi et al. discloses wherein: in the case that said wireless unit judging means judges that the wireless unit is not present, said setting means stores the setting information received by said setting information receiving means into first storage means (fig. 36-37, paragraphs [0331]-[0337]).

29. Consider claim 26, and as applied to claim 25 above, Miyakoshi et al. discloses wherein in such a case that after said setting means has stored said received setting information into said first storage means, said wireless unit judging means judges that a

wireless unit is additionally provided, said setting means derives said stored setting information from said first storage means and then sets said derived setting information to said additionally provided wireless unit (fig. 36-37, paragraphs [0331]-[0339]).

30. Consider claim 27, and as applied to claim 24 above, Miyakoshi et al. discloses wherein in such a case that even when the wireless unit is present, said wireless unit judging means judges that said wireless unit does setting information received by said setting information receiving means, said wireless unit judging means judges that the wireless unit is not present (fig. 36-37, paragraphs [0331]-[0339]).

31. Consider claim 28, and as applied to claim 24 above, Miyakoshi et al. discloses wherein both said setting information requesting means and said setting information receiving means transmit and receive either a request or information via a wire LAN interface with respect to said wireless access point (fig. 36-37, paragraphs [0331]-[0339]).

32. Consider claim 29, and as applied to claim 24 above, Miyakoshi et al. discloses wherein said setting information includes network setting information (abstract, paragraphs [0080]-[0120]).

33. Consider claim 30, and as applied to claim 24 above, Miyakoshi et al. discloses wherein said setting information requesting means requests any one of setting information containing wireless setting information, and setting information containing both said wireless setting information and further network setting information with respect to said wireless access point (fig. 36-37, paragraphs [0331]-[0337]).

Claim Rejections - 35 USC § 103

34. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

35. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

36. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

37. Claims 7 & 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miyakoshi et al. and in view of examiners official notice.

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38. Consider claims 7 & 19, and as applied to claims 5 & 18 above, Miyakoshi et al. discloses wherein said switching operation is carried out by way automation and program control and peripherals in network.

However, Miyakoshi et al. does not disclose a mechanical switch to perform switching operation.

Nevertheless, examiner takes official notice that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the invention of Miyakoshi et al. to specifically include a mechanical switch to perform switching operation for the purpose of being cost effective as well as easy or easier to understand, to manufacture, and/or to operate.

Conclusion

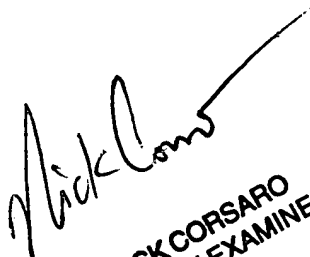
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Diego Herrera whose telephone number is (571) 272-0907. The examiner can normally be reached on Monday-Friday, 6:30AM-3:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kincaid G. Lester can be reached on (571) 272-7922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

D.H.


NICK CORSARO
PRIMARY EXAMINER